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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,617	07/27/2006	Reinhard Leigraf	VOI0368.US	9960
41863	7590	07/22/2010	EXAMINER	
TAYLOR IP, P.C. P.O. Box 560 142. S Main Street Avilla, IN 46710			TRAN, BINH X	
			ART UNIT	PAPER NUMBER
			1713	
			MAIL DATE	DELIVERY MODE
			07/22/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/587,617	<b>Applicant(s)</b> LEIGRAF ET AL.	
	<b>Examiner</b> BINH X. TRAN	<b>Art Unit</b> 1713	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112, 2<sup>nd</sup> paragraph rejections.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 26-30, 32-38 and 52.  
 Claim(s) withdrawn from consideration: 39-51.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

/BINH X TRAN/  
 Primary Examiner, Art Unit 1713

Continuation of 11. does NOT place the application in condition for allowance because: Regarding to previous 35 USC 103(a) rejection, the applicants state

"Bobsein, et al. disclose a paper having an improved print quality and method of making the same including having a sheet gloss, as defined in table 3, of approximately 30% (paragraph 54 and 62).

In contrast, claim 26 as amended, recites in part:  
said roughness level and said gloss value in combination having values that lie within a triangularly shaped region defined by a first point, a second point, and a third point, said first point being 0.8 micron roughness level and 3% gloss value, said second point being 0.8 micron roughness level and 35% gloss value, said third point being 3.9 micron roughness level and 3% gloss value.  
(Emphasis added). Applicants submit that such an invention is neither taught, disclosed, nor suggested by Korhonen, Bobsein, et al. or any of the other cited references, alone or in combination, and includes distinct advantages thereover."

The examiner strongly disagrees with this argument. The examiner clearly recognizes that Bobsein discloses a sheet gloss value of approximately 30% in Table 3. However, Bobsein also discloses a Sheet gloss value in the range of 4.2% to 19.9% in Table 2; or 19.5 % or 19.9% in Table 4; or 4.7% to 15.9% in Table 6; or 4.7% to 14.8% in Table 9. The examiner still maintains that the combination of Korhonen having a roughness range of 2.2 to 3.4 micron in combination with the Bobsein's Gloss value in Table 2, Table 4, Table 6 or Table 9 lie within the triangular shape defined by "a first point, a second point, and a third point, said first point being 0.8 micron roughness level and 3% gloss value, said second point being 0.8 micron roughness level and 35% gloss value, said third point being 3.9 micron roughness level and 3% gloss value." For the 35 USC 103(a) rejection, the examiner only need to show the combination of the prior arts teach at least ONE embodiment read on applicant's claimed invention. The examiner does not need to prove that ALL of the prior arts embodiment read on applicant's claimed invention. Thus, the examiner still maintains the previous ground of rejection under 35 USC 103(a).

Regarding to claim 52, the applicants state "Johnson et al. disclose a multi-layer printable wear resistant paper, with Figs. 1 and 3 both being schematic diagrams of a papermaking process. These figures show the web hanging in midair, which infers that some further processing will follow. These figures and the cited prior art fail to recite the claimed negative limitation. Applicants' claimed invention is a method that specifically excludes the paper web from being led through any further smoothing or calendering device once the paper web has been coated. This is a negative limitation that is discussed in the specification as originally filed and it is used to exclude the prior art as provided for in MPEP 2173.05(i)". The examiner strongly disagrees with this argument. First, Johnson never discloses that his paper making process is using a smoothing or calendering device. Thus, the examiner interprets that Johnson's paper web is no longer led through any further smoothing or calendering device. Second, in paragraph [0024], Johnson describes a paper making process wherein the last step is "the wear resistant overlay 22 is dried and prepared for shipping is known in the art". Thus, the examiner still maintains the previous ground of rejection under 35 USC 103(a).

/Binh X Tran/